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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/779,985	02/17/2004	David Huang	EQUUS-106A	8892
7590 12/21/2006 Bruce B. Brunda STETINA BRUNDA GARRED & BRUCKER Suite 250 75 Enterprise Aliso Viejo, CA 92656			EXAMINER BROADHEAD, BRIAN J	
			ART UNIT	PAPER NUMBER
			3661	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		12/21/2006	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/779,985

Applicant(s)

HUANG, DAVID

Examiner

Brian J. Broadhead

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8-28-06 has been entered.

Claim Objections

2. Claims 34 and 36 are objected to because of the following informalities:
3. In claim 34, the limitation of "at least one communication protocol" is recited but it does not refer back to the previously recited communication protocols. Is this the same communication protocols or a different one? It is assumed they are the same communication protocols. Also in claims 34, on line 4, the limitation of "the plurality of the protocols" is recited. It is assumed that this should be "the plurality of communication protocols".
4. In claim 36, the claim recites "the plurality of communication protocols comprise....". Do these protocols replace the protocols of claim 35, or should the claim have read "further comprises"? Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claims 30, 31, and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 30 recites the limitation "the associated communication protocol(s)" in line 1. There is insufficient antecedent basis for this limitation in the claim.

8. Claim 34 recites the limitation "the vehicles on-board diagnostic system" in line 7. There is insufficient antecedent basis for this limitation in the claim.

9. The remaining claims are indefinite via dependency.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claims 24, 25, 26, 27, 28, 29, 32, 33, 35, and 36, are rejected under 35 U.S.C. 102(b) as being fully anticipated by Alfaro et al., 5491418.

3. Alfaro et al. disclose connecting a protocol specific connector to a handheld diagnostic device, identifying physical features of the connector, the physical features directly identifying at least one communication protocol associated with the vehicle under test, retrieving configuration data associated with the communication protocol, and configuring the diagnostic device in accordance with the retrieved configuration data on line 58, on column 1, through line 2, on column 2; the step of identifying

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physical features of the connector includes identifying the connector connectivity configuration and identifying the connector pin configuration on lines 40-50, on column 3, and lines 24-28, on column 3; the step of identifying physical features of the connector comprises performing a continuity test to identify whether continuity exists between specific pins of the connector on lines 55-60, on column 3; determining if the connector is a standard OBD-2 connector on line 2, on column 3, SAE J 1962 is the specification for OBD-2 DLCs; the method is performed with the device disconnected from the vehicle diagnostic port on lines 55-64, on column 3, here it states the connector provides the configuration information and connection to the vehicle is not required; a CPU 78, memory on lines 31-32, on column 8; a protocol specific connector for connecting the device to the diagnostic port (10); the connector having features recognizable by the CPU as corresponding to at least one associated comm. protocol on lines 1-35, on column 3; a look up table identifying diagnostic configuration data on lines 25-34, on column 8; and the CPU configuring the diagnostic device in accordance with the configuration data on lines 45-67, on column 6.

4. Claims 24-36 are rejected under 35 U.S.C. 102(a) as being fully anticipated by the admitted prior art.

5. The admitted prior art in the specification in paragraphs 6-11 reads on the claimed invention. The main difference appears to be trying to make the device portable but this is only recited in the pre-amble of the claims and is not given patentable weight.

Claim Rejections - 35 USC § 103

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6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 30, 31, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alfaro et al., 5491418, in view of Mitcham et al, EPA420-R-00-017.

8. Alfaro et al. disclose the limitations as set forth above. They do not disclose serially polling the OBD system using each of the plurality of communication protocols until successful communication is established between the device and the vehicle OBD, or this is accomplished with a sequencer. Mitcham et al. teaches that the OBD-2 regulations adopted by the federal government require automatic hands-off determination of the communication protocol on page 6. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teaching of Mitcham et al. in the invention of Alfaro et al. because it would make the device of Alfaro et al. comply with government regulations.

Response to Arguments

9. Applicant's arguments filed 10-4-06 have been fully considered but they are not persuasive. The argument that Alfaro does not correlate a specific plug to a communication protocol and is more "derivative" in nature through a database is not convincing. In reading lines 15-60, on column 5, of Alfaro et al. it is clear that they use the ID in the adapter (connector 10) to reconfigure the serial communication. This is synonymous with using different protocols depending on the adapter used. Applicant

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has failed to point out how the claim language overcomes the reference. Applicant makes several assertions that his invention is superior because of such things as needing fewer connector, and less memory, but has failed to point out where in the claims these features are located. Applicant also states that Alfaro seems more appropriate for pre- OBD-2 vehicles but this runs contrary to the disclosure of using the SAE J1962 which is part of the requirements for OBD-2. Applicant also seems to overlook that discussion of Alfaro on lines 30-67, on column 8, of the initialization of serial communication based on the ID provided by the adapter. In other words, based on the connector or adapter, protocols are looked up in the memory and then the hardware of Alfaro is configured to the appropriate protocol.

10. Applicant also seems to admit in the specification that the claimed subject matter is known. There is discussion that there is not a handheld version of the known prior art, but the limitation of being handheld is not given patentable weight since it only appears in the preamble of the claims. Even if the limitation of being handheld and portable was to be given patentable weight the change would be obvious to one of ordinary skill in the art (See *In re Lindberg*, 93 USPQ 23 (CCPA(1952))).

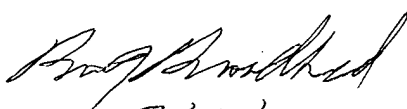
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Broadhead whose telephone number is 571-272-6957. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Black can be reached on 571-272-6956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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